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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,485	08/27/2001	Chikako Kariya	1484.1007	2872
21171	7590	06/12/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/938,485

Applicant(s)

KARIYA, CHIKAKO

Examin r

CESAR B. PAULA

Art Unit

2178

-- The MAILING DATE of this communicati n appears n the c ver she t with the correspondence address --

**Peri d for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8,10-18,20-27,29-37,39-46 and 48-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,10-18,20-27,29-37,39-46 and 48-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Pat nt Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to the remarks filed on 3/23/2006.

**This action is made Final.**

2. In the remarks, claims 1-8, 10-18, 20-27, 29-37, 39-46, and 48-56 are pending in the case. Claims 1, 11, 20, 30, 39, and 49, are independent claims.

#### *Priority*

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 200-373784 filed in Japan on 12/8/2000, which papers have been placed of record in the file.

#### *Drawings*

4. The drawings filed on 8/27/2001 have been approved by the examiner.

#### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8, 10-18, 20-27, 29-37, 39-46, and 48-56 remain rejected under 35

U.S.C. 103(a) as being unpatentable over Moody et al, hereinafter Moody (Pat.# 5,890,177, 3/30/1999), in view of "Getting Results with Microsoft Office 97", hereinafter Office, Microsoft Corporation, 1997, pages 396-401.

Regarding independent claim 1, Moody discloses comparing an original document and an edited copy of the same document to determine similarities, and differences, if any, among the documents, which are emailed among an author and editors—*the documents are electronic mail documents* (col.7, lines 21-67, col.4, lines 34-51).

Furthermore, Moody discloses the comparison of similarities and differences—*relevance information--* between paragraphs of two documents emailed between the author, and editors—*exchange history of the electronic mail documents--* such as an original document, and an edited copy of the original document (which was edited, after the original document was created—*timewise latest document--* based on a heritage —*header--* containing a timestamp—*timewise order--* indicating when the document was created or edited) (col.10, lines 15-35, col.4, lines 34-51). Moody fails to explicitly disclose *the documents are electronic mail*. However, Office teaches sending a copy of the document a user is working on, to a recipient as an email (page 399). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Moody, and Office, because Office teaches getting quick feedback from reviewers (page 396). This would provide the time-saving benefit of directly emailing the

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documents the user has created using the sophisticated features of the application, such as the wordprocessing application.

Regarding claim 2, which depends on claim 1, Moody discloses the comparison of similarities or differences between paragraphs of two documents, based on a creator ID —*header information* (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 3, which depends on claim 2, Moody discloses presenting or displaying the documents and their similarities and differences—*relevance information--* in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies—*outputs the relevance information in a timewise order--* (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 4, which depends on claim 1, Moody discloses presenting or displaying the documents and their similarities and differences in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 5, which depends on claim 4, Moody discloses presenting or displaying the documents and their similarities and differences in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 6, which depends on claim 5, Moody discloses presenting or displaying the documents—*document selected at the locator*-- and their similarities and differences in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 7, which depends on claim 2, Moody discloses the comparison of differences—*branched state*-- between paragraphs of two documents, based on a creator ID — *header information according to a uniqueness rule in each of the documents*. The differences or edits—*detected branched state*-- are presented in a visible way using techniques such as redlining (col. 6, lines 1-67, col.10, lines 15-35).

Regarding claim 8, which depends on claim 5, Moody discloses the comparison of differences—*branched state*-- between paragraphs of two documents, based on a creator ID — *header information according to a uniqueness rule in each of the documents*. The differences or edits—*detected branched state*-- are presented in a visible way using techniques such as redlining , in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 10, which depends on claim 1, discloses returning edited copies of the original document back to the author using email—*the documents located by the locator are*

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*subjected to a return mail processing.* The documents are arranged in a hierarchical tree-like order in a markup document (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding independent claim 11, Moody discloses comparing an original document and an edited copy of the same document to determine differences, if any, among the documents, which are emailed between an author and editors—*the documents are electronic mail documents* (col.7, lines 21-67, col.4, lines 34-51).

Moreover, Moody discloses a word processing software for deleting duplicate paragraphs of the documents, and producing a final document (col.7, lines 1-20). In other words, the software is used to go through all the paragraphs and removes the duplicate paragraphs, and creates a final document without the duplicate paragraphs—*parsing overlapped portion of information and for merging the documents with the overlapped portion eliminated.* A comparison of similarities and differences—*relevance information--* between paragraphs of two documents emailed among the author, and editors—*exchange history of the electronic mail documents*—is determined by the software.

Regarding claim 12, which depends on claim 11, Moody discloses the merging of the final document by using a document containing various editions of the original document organized in an order that presents the original paragraphs first, followed by other edited paragraphs—*merges the documents according to an order of the related documents* (col.6, lines 56-67, fig.3).

Regarding claim 13, which depends on claim 11, Moody discloses the comparison of paragraphs based on an on heritage containing an ID of the editor who made the edits to the corresponding document—*detect relevance among the documents based on the header information* or editor initials (col.10, lines 15-35).

Regarding claim 14, which depends on claim 13, Moody discloses the comparison of paragraphs of two documents, based on a heritage —*header--* containing a timestamp—*timewise order--* indicating when the document was created or edited—*detect relevance among the documents based on the header information* or editor initials. The differences or edits are presented in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies—*timewise order* (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 15, which depends on claim 11, Moody discloses the display of a markup document containing various editions—*relevance documents--* of the original document organized in a tree order that presents the original paragraphs first, followed by other edited paragraphs (col.6, lines 56-67, fig.3).

Regarding claim 16, which depends on claim 15, Moody discloses using the markup document containing various editions, and which is displayed in a tree order, for producing, and displaying a final document creating by merging several of the edited documents—*relevance*



*documents--* of the original document organized in an order that presents the original paragraphs first, followed by other edited paragraphs (col.6, lines 56-col.7, line 20, fig.3).

Regarding claim 17, which depends on claim 13, Moody discloses the comparison of differences—*branched state--* between paragraphs of two documents, based on a creator ID — *header information according to a uniqueness rule in each of the documents*. The differences or edits—*detected branched state--* are presented in a visible way using techniques such as redlining (col. 6, lines 1-67, col.10, lines 15-35).

Regarding claim 18, which depends on claim 15, Moody discloses the comparison of differences—*branched state--* between paragraphs of two documents, based on a creator ID — *header information according to a uniqueness rule in each of the documents*. The differences or edits—*detected branched state--* are presented in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Claims 20-37 are directed towards a computer program product on a computer-readable medium for performing the steps found in claims 1-18 respectively, and therefore are similarly rejected.

Claims 39-46, 48-56 are directed towards a method for implementing the device found in claims 1-8, and 10-18, respectively, and therefore are similarly rejected.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-8, 10-18, 20-27, 29-37, 39-46, and 48-56 have been considered but are not persuasive. The Applicant indicates that the Examiner appears to be misstating the teachings of Office, since Office teaches the transmission of documents as email attachments, and not the documents themselves as email (pages 10-12). The Examiner disagrees, because Office teaches using Word as an email editor to compose and reply to messages (page 396). Word is used to create, edit email, and transmit messages just like Microsoft Exchange or any other email application. The messages composed by an email application are not transmitted as an attachment, and so are not the documents composed by an application, such as Word as indicated above, and as witnessed by Microsoft Office 2000. screendumps (figs. 1-4), which show a Word document being composed, and mailed as a document not as an attachment.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)

  
CESAR PAULA  
PRIMARY EXAMINER

6/7/06